

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Dan Kikinis *et al.*

Serial No.: 09/661,164

Filed: September 13, 2000

For: SYSTEM AND METHOD FOR
INSERTION OF RECORDED MEDIA
INTO A BROADCAST

Atty. Docket No.: 007287.00043

Group Art Unit: 2424

Examiner: Joseph G. Ustaris

Confirmation No.: 7516

APPEAL BRIEF

U.S. Patent and Trademark Office
Customer Service Window
Mail Stop - Appeal
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

This is an Appeal Brief filed in support of Appellants' March 2, 2009, Notice of Appeal and Pre-Appeal Brief Request for Review. Appeal is taken from the Final Office Action mailed December 2, 2008 (hereafter, "Final Office Action"), and the Notice of Panel Decision from Pre-Appeal Brief Review mailed April 24, 2009.

Please charge any fees to Deposit Account No. 19-0733. In addition, any extensions of time necessary for acceptance or entry of this paper are hereby requested.

REAL PARTY IN INTEREST

37 C.F.R. § 41.37(c)(1)(i)

The owner of this application, and the real party in interest, is JLB Ventures, LLC.

RELATED APPEALS AND INTERFERENCES

37 C.F.R. § 41.37(c)(1)(ii)

There are no related appeals or interferences.

STATUS OF CLAIMS

37 C.F.R. § 41.37(c)(1)(iii)

Claims 1-19, 26-34, 37 and 38 are rejected and presently appealed.

Claims 20-25, 35 and 36 have been canceled.

STATUS OF AMENDMENTS

37 C.F.R. § 41.37(c)(1)(iv)

No amendments have been made subsequent to final rejection.

SUMMARY OF CLAIMED SUBJECT MATTER

37 C.F.R. § 41.37(c)(1)(v)

In making reference herein to various embodiments in the specification text and/or drawings to explain the claimed invention, Appellants do not intend to limit the claims to those embodiments; all references to the specification and drawings are illustrative unless otherwise explicitly stated. Appellants refer to the originally filed Specification dated September 13, 2000 ("Specification"), for the cited support.

Independent claim 1 is directed to a set-top box, comprising memory storing computer readable instructions that, when executed, cause the set top box to perform various functions. Specification at p. 7, line 1- 21; p. 9, lines 11-20. The functions include receiving a broadcast stream, wherein a portion of the broadcast stream having a first priority indicator. *Id.* at p. 9, lines 21-22; p. 10, lines 7-9. The set top box may further receive media separate from the broadcast stream, wherein the media having a second priority indicator greater than the first priority indicator. *Id.* at p. 11, lines 19-22; p. 10, lines 7-9. A signal may subsequently be received by the set top box, where the signal is configured to modify the first priority indicator

from a first priority to a second priority. *Id.* at p. 12, lines 1-4. The first priority indicator may then be modified from the first priority to the second priority in response to receiving the signal. *Id.* The set top box may also determine whether the modified first priority indicator is greater than the second priority indicator, and replace the portion of the broadcast stream with the separate media in response to determining that the modified first priority indicator is lower than the second priority indicator. *Id.* at p. 12, lines 1-9; p. 14, lines 9-14.

Independent claim 11 is directed to a method that includes receiving, at a set-top box, a broadcast stream having a first priority indicator, wherein the first priority indicator is associated with a portion of the first broadcast stream. Specification at p. 9, lines 21-22; p. 10, lines 7-9. The method further includes receiving, at the set-top box, media separate from the broadcast stream and having a second priority indicator lower than the first priority indicator. *Id.* at p. 11, lines 19-22; p. 10, lines 7-9. Additionally, the method includes receiving, at the set-top box, a signal configured to modify the first priority indicator from a first priority to a second priority and modifying, at the set-top box, the first priority indicator from a first priority to a second priority in response to receiving the signal. *Id.* at p. 12, lines 1-4. The method further includes determining, at the set-top box, whether the modified first priority indicator is greater than the second priority indicator and in response to determining that the modified first priority indicator is lower than the second priority indicator, inserting the separate media into the broadcast stream. *Id.* at p. 12, lines 1-9; p. 14, lines 9-14.

Independent claim 26 is directed to a tangible computer readable medium embodying instructions executable by a set top box. Specification at p. 7, line 1- 21; p. 9, lines 11-20. The instructions are executable by the set top box to perform a method including receiving a broadcast stream having a first priority indicator, wherein the first priority indicator is associated with a portion of the broadcast stream. *Id.* at p. 9, lines 21-22; p. 10, lines 7-9. The instructions are further executable by the set top box to receive a separate media having a second priority indicator lower than the first priority indicator. *Id.* at p. 11, lines 19-22; p. 10, lines 7-9. The set top box may further receive a signal to modify the first priority indicator from a first priority to a second priority and modify the first priority indicator from the first priority to the second priority in response to receiving the signal. *Id.* at p. 12, lines 1-4. Further, the instructions are executable by the set top box to determine whether the modified first priority indicator is greater than the

second priority indicator and in response to determining that the modified first priority indicator is lower than the second priority indicator, inserting the separate media into the broadcast stream. *Id.* at p. 12, lines 1-9; p. 14, lines 9-14.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

37 C.F.R. § 41.37(c)(1)(vi)

- Claims 1-6, 9-16, 18, 26-31, 33 and 34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Reynolds *et al.* (U.S. Patent Pub. No. 2001/0037500, “Reynolds”), Gordon *et al.* (U.S. Patent Pub. No. 2001/0014975, “Gordon”) and Zigmond *et al.* (U.S. Patent No. 6,698,020, “Zigmond”).
- Claims 7, 19 and 37 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Reynolds, Gordon and Zigmond, and in further view of Blackketter *et al.* (U.S. Patent Pub. No. 2002/0056129, “Blackketter”).
- Claim 8, 17 and 32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Reynolds in view of Gordon, Zigmond and Bullock *et al.* (U.S. Patent No. 5,070,404, “Bullock”).
- Claim 38 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Reynolds, Gordon, Zigmond and Robinett *et al.* (U.S. Patent No. 6,351,474, “Robinett”).

ARGUMENT

37 C.F.R. § 41.37(c)(1)(vii)

A. Rejection of Claims 1-6, 9-16, 18, 26-31, 33 and 34 over Reynolds in view of Gordon and Zigmond

1. Independent Claim 1

Independent claim 1 recites, among other features, a set-top box receiving media separate from a broadcast stream, the media having a second priority indicator greater than a first priority indicator of the broadcast stream, receiving a signal configured to modify the first priority indicator from a first priority to a second priority, and modifying the first priority indicator from the first priority to the second priority in response to receiving the signal. The Final Office Action concedes at p. 6, that Reynolds does not explicitly disclose such features. Instead, the Final Office Action relies on Gordon to allegedly teach the above recited features.

Contrary to the Office Action's assertions and as discussed in Applicants' Pre-Appeal Brief Request For Review, dated March 2, 2009, at page 2, however, Gordon describes that it is the local servers, not the set-top boxes, that have intelligence to resolve conflicts and to assign different priorities as necessary. p. 4, paras. [0063]-[0065]. The Final Office Action asserts at p. 3 that "Gordon does disclose a process/method (e.g. changing priorities in response to a received signal) that is well known in the art and are used to perform functions that are also well known in the art (e.g. changing priorities). Therefore, one of ordinary skill would recognize that such a process/method could be placed in various embodiments (e.g. in a local server or in a set-top box) and still would produce a predictable result (e.g. producing changing priorities in response to a received signal)." However, the mere fact that a combination might result in a predictable result (which Applicants do not concede) amounts to a mere conclusory statement and does not satisfy the obviousness inquiry. "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006) (cited with approval in *KSR*). Here, the Final Office Action fails to provide any articulated reasoning or analysis to support its conclusion of obviousness. For example, the Final Office Action fails to provide a reason why one of ordinary skill in the art would place the intelligence for resolving priority conflicts (as discussed in Gordon) in the set-top box receivers of the Gordon system. Indeed, Applicants submit that it would not have been obvious to combine the references in the asserted manner because the purpose of Gordon is to alleviate bandwidth and storage requirements of an interactive television network by using local servers to resolve priority conflicts and to store subsets of data objects. *See, e.g.*, para. [0011]. Placing such a burden on the set-top boxes in Gordon would reduce the efficiencies sought by Gordon in using the local servers to perform such tasks.

Claim 1 is allowable over the applied references for at least the foregoing reasons (notwithstanding whether any combination of the applied references is proper).

2. Independent Claim 11

Independent claim 11 recites, *inter alia*, "receiving, at a set-top box, a broadcast stream having a first priority indicator, wherein the first priority indicator is associated with a portion of

the first broadcast stream; receiving, at the set-top box, media separate from the broadcast stream and having a second priority indicator lower than the first priority indicator; receiving, at the set-top box, a signal configured to modify the first priority indicator from a first priority to a second priority; modifying, at the set-top box, the first priority indicator from a first priority to a second priority in response to receiving the signal; determining, at the set-top box, whether the modified first priority indicator is greater than the second priority indicator; and in response to determining that the modified first priority indicator is lower than the second priority indicator, inserting the separate media into the broadcast stream.” As discussed above with respect to claim 1, there would be no reason to combine Reynolds, Gordon and Zigmond such that the intelligence for resolving priority conflicts is placed in the set-top box receivers. Accordingly, claim 11 is allowable for at least these reasons.

3. Independent Claim 26

Claim 26 recites features similar to those discussed above with respect to claims 1 and 11 and is thus allowable for substantially the same reasons as claims 1 and 11.

4. Dependent Claims 2-6, 9, 10, 12-16, 18, 27-31, 33 and 34

Claims 2-6, 9, 10, 12-16, 18, 27-31, 33 and 34 are dependent claims and are thus allowable over the applied references for at least the same reasons as their respective base claims.

B. Rejection of Claims 7, 19 and 37 over Reynolds, Gordon, Zigmond and Blacketter

Claims 7, 19 and 37 are dependent claims. Blacketter fails to cure the deficiencies discussed above with respect to claims 1, 11 and 26. Accordingly, claims 1, 11 and 26 and their dependent claims (including claims 7, 19 and 37) are allowable over this asserted combination for at least the same reasons as noted above.

C. Rejection of Claims 8, 17 and 32 over Reynolds, Gordon, Zigmond and Bullock

Claims 8, 17 and 32 are dependent claims. Bullock fails to cure the deficiencies discussed above with respect to claims 1, 11 and 26. Accordingly, claims 1, 11 and 26 and their

dependent claims (including claims 8, 17 and 32) are allowable over this asserted combination for at least the same reasons as noted above.

D. Rejection of Claim 38 over Reynolds, Gordon, Zigmond and Robinett

Claim 38 is dependent on claim 1. Robinett does not cure the deficiencies discussed above with respect to claim 1. Accordingly, claim 1 and its dependent claims (including claim 38) are allowable over this asserted combination for at least the same reasons as noted above.

Additionally, claim 38 recites, *inter alia*, “determine that the first priority indicator is greater than the second priority indicator prior to receiving the signal; and delaying the insertion of the separate media into the broadcast stream until the first priority indicator is modified.” Robinett does not teach or suggest such features. The Final Office Action appears to analogize the delay of the insertion of the separate media into a broadcast stream until the first priority indicator is modified to delaying an insertion of a changed PID mapping until a new/modified version of the PMT or CAT is available. Col. 32, line 56 – Col. 33, line 7. Even assuming that Robinett describes delaying the insertion of a changed PID mapping, Applicants respectfully disagree with such an analogy. Specifically, a PID (i.e., packet identifier) mapping does not constitute separate media that is inserted into a broadcast stream. Additionally, nowhere does Robinett teach or suggest that the insertion of the separate media is delayed until the first priority indicator is modified. Not only does the PMT or CAT fail to describe a priority indicator, Robinett does not teach or suggest that insertion is delayed until the PMT or CAT is modified. Instead, Robinett states that any changes to PID mapping are preferably delayed until a new version of the PMT can be *outputted* in the TS. Outputting does not constitute modifying. Accordingly, claim 38 is allowable for this additional reason.

CONCLUSION

For all of the foregoing reasons, Appellant respectfully submits that the final rejection of claims 1-19, 26-34, 37 and 38 is improper and should be reversed.

Respectfully submitted,
BANNER & WITCOFF, LTD.

Dated: May 26, 2009

By: /Chunhsi Andy Mu/
Chunhsi Andy Mu
Registration No. 58,216

1100 13th Street, N.W., Suite 1200
Washington, D.C. 20005-4051
Tel: (202) 824-3000
Fax: (202) 824-3001

CLAIMS APPENDIX
37 C.F.R. § 41.37(c)(1)(viii)

Claims involved in the appeal:

Claim 1: A set-top box, comprising:

memory storing computer readable instructions that, when executed, cause the set top box to:

receive a broadcast stream, a portion of the broadcast stream having a first priority indicator;

receive media separate from the broadcast stream, the media having a second priority indicator greater than the first priority indicator;

receive a signal configured to modify the first priority indicator from a first priority to a second priority;

modify the first priority indicator from the first priority to the second priority in response to receiving the signal;

determine whether the modified first priority indicator is greater than the second priority indicator; and

replace the portion of the broadcast stream with the separate media in response to determining that the modified first priority indicator is lower than the second priority indicator.

Claim 2: The set-top box of Claim 1 wherein the first and second priority indicators comprise at least one of a number, a letter, and a symbol.

Claim 3: The set-top box of Claim 1 wherein the separate media and the broadcast stream are the same media.

Claim 4: The set-top box of Claim 1 wherein the separate media and the broadcast stream are different media.

Claim 5: The set-top box of Claim 1 wherein an event triggers an insertion of the separate media into the broadcast stream.

Claim 6: The set-top box of Claim 5 wherein the event includes an arrival of an e-mail message.

Claim 7: The set-top box of Claim 1 wherein the signal configured to change the first priority indicator is programmed by a time mark.

Claim 8: The set-top box of Claim 1 wherein one or more additional priority indicators are associated with the broadcast stream using at least one of a pilot tone and a watermark.

Claim 9: The set-top box of Claim 1 wherein the first and second priority indicators are user specified.

Claim 10: The set-top box of Claim 1 wherein the set-top box is part of a television system or radio system.

Claim 11: A method of inserting media into a broadcast stream, the method comprising:

receiving, at a set-top box, a broadcast stream having a first priority indicator, wherein the first priority indicator is associated with a portion of the first broadcast stream;

receiving, at the set-top box, media separate from the broadcast stream and having a second priority indicator lower than the first priority indicator;

receiving, at the set-top box, a signal configured to modify the first priority indicator from a first priority to a second priority;

modifying, at the set-top box, the first priority indicator from a first priority to a second priority in response to receiving the signal;

determining, at the set-top box, whether the modified first priority indicator is greater than the second priority indicator; and

in response to determining that the modified first priority indicator is lower than the second priority indicator, inserting the separate media into the broadcast stream.

Claim 12: The method of Claim 11 wherein the first and second priority indicators comprise at least one of a number, letter and symbol.

Claim 13: The method of Claim 11 wherein the separate media and the broadcast stream are the same media.

Claim 14: The method of Claim 11 wherein the separate media and the broadcast stream are different media.

Claim 15: The method of Claim 11 wherein an event triggers an insertion of the separate media into the broadcast stream.

Claim 16: The method of Claim 15 wherein the event includes an arrival of an e-mail message.

Claim 17: The method of Claim 11 wherein a plurality of priority indicators are each associated with a different portion of the broadcast stream, wherein the plurality of priority indicators are embedded into the broadcast stream using at least one of a pilot tone and a watermark.

Claim 18: The method of Claim 11 wherein a plurality of priority indicators are each associated with a different portion of the broadcast stream based on a geographic area.

Claim 19: The method of Claim 11 wherein the signal configured to change the first priority indicator of the media insertion is programmed by a time mark, the time mark synchronizing the separate media insertion with the broadcast stream.

Claim 26: A tangible machine-readable storage medium embodying instructions executable by a set-top box to perform a method comprising:

receiving a broadcast stream having a first priority indicator, wherein the first priority indicator is associated with a portion of the broadcast stream;

receiving a separate media having a second priority indicator lower than the first priority indicator;

receiving a signal to modify the first priority indicator from a first priority to a second priority;

modifying the first priority indicator from the first priority to the second priority in response to receiving the signal;

determining whether the modified first priority indicator is greater than the second priority indicator; and

in response to determining that the modified first priority indicator is lower than the second priority indicator, inserting the separate media into the broadcast stream.

Claim 27: The machine-readable storage medium of Claim 26 wherein the first and second priority indicators comprise at least one of a number, a letter and a symbol.

Claim 28: The machine-readable storage medium of Claim 26 wherein the separate media and the broadcast stream are the same media.

Claim 29: The machine-readable storage medium of Claim 26 wherein the separate media and the broadcast stream are different media.

Claim 30: The machine-readable storage medium of Claim 26 wherein an event triggers an insertion of the separate media into the broadcast stream.

Claim 31: The machine-readable storage medium of Claim 30 wherein the event includes an arrival of an e-mail message.

Claim 32: The machine-readable storage medium of Claim 26 wherein a plurality of additional priority indicators are each associated with a different portion of the broadcast stream, the plurality of additional priority indicators embedded into the broadcast stream using a pilot tone or watermark.

Claim 33: The machine-readable storage medium of Claim 26 wherein a plurality of additional priority indicators are each associated with a different portion of the broadcast stream based on a subdivision or geographic area, the plurality of additional priority indicators allowing broadcasters to sell advertising space for the particular subdivision or geographic area.

Claim 34: The machine-readable storage medium of Claim 26 wherein the priority indicators are user assigned to the separate media.

Claim 37: The set-top box of claim 1, wherein the signal is programmed by a time mark.

Claim 38: The set-top box of claim 1, wherein the memory further includes instructions that, when executed, cause the set-top box to:

determine that the first priority indicator is greater than the second priority indicator prior to receiving the signal; and

delaying the insertion of the separate media into the broadcast stream until the first priority indicator is modified.

EVIDENCE APPENDIX

37 C.F.R. § 41.37(c)(1)(ix)

NONE.

RELATED PROCEEDINGS APPENDIX

37 C.F.R. § 41.37(c)(1)(x)

NONE.